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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,049

Applicant(s)

BARRUS, JOHN W.

Examiner

Quoc A. Tran

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 and 66-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 and 66-77 is/are rejected.
- 7) ☒ Claim(s) 1-64, and 66-67 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/27/2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This is a Non-Final Office Action. This action is responsive to RCE/Amendments/Remarks, which was filed on 02/27/2008.

Claims 1-64, and 66-77 are currently pending, with claims 1, 33, 34, and 61 being the independent claims. Claim 65 was previously canceled. Applicant has amended independent claims 1, 3, 29, 33, 34, and 61.

The terminal disclaimer for copending patent application number 10/665,097 was filed on 09-14-2006 and was approved on 9/21/2006. Accordingly, the double patenting rejection was previously withdrawn in the Office Action dated 12/04/2006.

Effective filing date is 03-31-2004, CIP of 10/404,916 filed 03-31-2003 (Assignee: Ricoh).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/27/2008 has been entered.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

Claims 1-64 and 66-77, particularly independent claims 1, 33, 34 and 61 recite the limitations "*a third plurality of document;*" and "*a fourth plurality of action*". However, there is not any support for the phrases "*a third plurality of document;*" and "*a fourth plurality of actions*". that is defined in the Applicant's original disclosure. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

In addition, claims 61, recites the limitations "*a document index input device*". However, there is not any support for the phrases in the Applicant's original disclosure. Eventhought, the Applicant disclosed the term "*device*" through out the Specification, but there is not any supported for the phase "*a document index input device*". See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a), because:

Claims 1-64 and 66-77; particularly independent claims 1, 33, 34 and 61 recite the limitation "*a third plurality of document;*" and "*a fourth plurality of action*"; however there in not any supported for the recited limitation as claimed.

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It is noted the Applicant's disclosure merely stated, "In the example of Fig. 3, check boxes 501sub 1, 503A1-503H3, and 515 are located on coversheet 101. Check boxes 503A1-503H3, are printed on thumbnail representations 503A-H, respectively." See the Applicant disclosure at Page 14 Para 34, and also see Fig. 3 of the Drawings, Thus independent claims 1, 33, 34 and 61 claimed limitation is not in consistent with the original Drawings.

Accordingly, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the limitation disclosed in claims 1-64 and 66-77, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

Claim 3 is objected to because of the following informalities:

All paragraphs in the claim, which follows the "*Original*", however, claim 3 is currently amended- see claim 3 of paper dated 02/27/2008 Page 3 Line 2. Therefore the corrected claim identifier is "Currently Amended" rather than "Original". See MPEP 37 CFR 1.121.

Appropriate correction is required.

In addition, claims 62-64, and 66-77 are objected to because of the following:

Claims 62-64, recites the limitation "*Apparatus defined in claim 61*". However, there is not any support for the term "Apparatus" that is defined in

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claimed 61 (see Claim 61 Page 13). See 37 CFR 1.75(d)(1) and MPEP

§ 608.01(o). Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-64 and 66-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klotz, Jr. et al. U.S. Patent No. 5,682,540 filed 12/08/1994 [hereinafter "Klotz"], in view of Grasso, et al. US 20020080387A1, filed 12/22/2000 [hereinafter "Grasso"].

Regarding ***independent claim 1***,

Klotz teaches:

A computer-implemented method comprising: receiving an image of an overview of a collection that comprises a first plurality of indication areas associated with a third plurality of documents,

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line

45 → Klotz discloses this limitation in that item 32 is a barcode represented

documents items 84, included documents check boxes (i.e. marked) item 82 and

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the document reduced images item 86 as illustrated in Fig. 4 below:

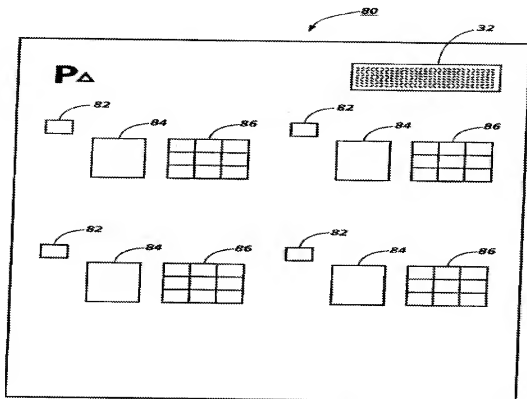


Fig. 4

and the identifying the at least one document from the third plurality of documents is performed based on the first plurality of the indication areas in the image;

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

In addition Klotz does not expressly teach, but Grasso teaches:

and a second plurality of indication areas associated with a fourth plurality of actions; identifying at least one action from the fourth plurality of action set forth in the image;

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as storing, copying, printing, publishing, deleting, add comments or rating.)

identifying at least one document from the third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image,

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as storing, copying, printing, publishing, deleting, add comments or rating.)

and performing the at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of action set forth in the image and the identifying the at least one document the third plurality of documents from the image.

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as storing, copying, printing, publishing, deleting, add comments or rating.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said identifying at least one document from the second, third plurality of documents, wherein the identifying the at least one action from the fourth plurality of actions set forth in the image is performed based on the second plurality of the indication areas in the image; and performing the at least one action on the at least one document in response to the identifying the at least one action from the fourth plurality of action set forth in the image and the identifying the at least one document the third plurality of documents from the image as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input /output device - See Grasso at the Abstract and at Para 9.

Regarding independent claim 33,

is fully incorporated similar subject of claim 1 cited above, and is similarly rejected along the same rationale. Thus, Klotz and Grasso disclose every limitation of Claim 33 and provide proper reasons to combine, as indicated in the above rejections for Claim 1.

In addition, Klotz teaches:

receiving a document index image of an overview of a collection, a machine readable pointer identifying the collection;

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Regarding independent claim 34:

is fully incorporated similar subject of claim 1 cited above, and is similarly rejected along the same rationale. Thus, Klotz and Grasso disclose every limitation of Claim 34 and provide proper reasons to combine, as indicated in the above rejections for Claim 1.

Regarding independent claim 61:

Claim 61 recites a system to implement a method recited in Claim 33. Thus, Klotz and Grasso disclose every limitation of Claim 34

and provide proper reasons to combine, as indicated in the above rejections for Claim 33- Also See Klotz at Fig.1, disclose computer system 10.)

In addition, Klotz teaches:

**a document processor, couple to document identifier and A
document identifier, couple to a marked check box locator,**

(See the Abstract → Klotz discloses this limitation in that the machine readable area comprises a document reference code that is readable (i.e. bar code) and recognizable by the document processing system.)

Claim 2:

Klotz and Grasso teach the method of claim 1 and further comprise:

**identifying a location on the image of at least one indication
area having a mark therein, the at least one indication area being
associated with the at least one document; and identifying the at
least one document based on the location of the at least one
indication area having the mark therein.**

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 3:

Klotz and Grasso teach the method of claim 2 and further comprise:

one of the first plurality of check boxes in the image, wherein each of the first plurality of check boxes is associated with one of a plurality of graphics in the image, wherein each of the plurality of graphics is associated with one or more documents.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 4:

Klotz and Grasso teach the method of claim 2 and further comprise:

wherein the collection overview comprises a plurality of representations of documents, and wherein identifying at least one document based on the location of the at least one indication area comprises identifying the at least one document corresponding to a document representation indicated by the mark in the at least one indication area;

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 5:

Klotz and Grasso teach the method of claim 2 and further comprise:

wherein identifying the at least one document based on the location of the at least one indication area having the mark therein comprises: determining a coordinate location for the at least one indication area having the mark therein; and determining a coordinate location for at least one of the document representations; identifying a first document by comparing the coordinate location for at least one indication area having the mark therein with the coordinate location for the at least one document representation.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 6:

Klotz and Grasso teach the method of claim 2 and further comprise:

wherein each of the at least one indication area comprises a check box.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 7:

Klotz and Grasso teach the method of claim 2 and further comprise:

wherein the indication area is located on top of a portion of a graphic representing at least one document in a collection.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 8:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein the image includes a machine readable pointer to identify the collection.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 9:

Klotz and Grasso teach the method of claim 8 and further comprise:

wherein the machine readable pointer comprises a 2-D barcode.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line

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45 → Klotz discloses this limitation in that item 32 is a barcode (i.e. 2D) represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 10:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein receiving an image of an overview of the collection comprises capturing an image of the sheet and identifying at least one document by reading an RFID tag embedded in the sheet, the data on the RFID tag identifying the collection containing a document.

(See Column 7, Lines 25-40 → Klotz discloses this limitation in that a document surrogate may contain a check box on the face of the surrogate (Check box 38 in FIG. 2A) If, for example, the user places a check mark in box 38, system 10 will detect its presence (i.e. RFID tag).

Claim 11:

Klotz and Grasso teach the method of claim 1 and further comprise:

scanning a sheet having an identifier and having graphical content representing a collection of one or more media objects, wherein scanning the sheet results in creating the image.

(See Column 8 Lines 60-67 → Klotz discloses this limitation in that the document processing system 10 scans document surrogate 62 and parses the machine

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readable code resident on the surrogate. A flag indicates that the sheet is a document surrogate to be processed accordingly, and then remotely distributed as the hardcopy version of associated object 64 via facsimile transmission or any other means of distribution, as depicted as output terminal 18.)

Claim 12:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein the plurality of actions comprise two or more of a group consisting of printing, faxing, sending by electronic mail, deleting, grouping, ungrouping, and playing.

(See Para → Klotz discloses this limitation in that a document surrogate may contain a check box on the face of the surrogate. Check box 38 in FIG. 2A is exemplary. If, for example, the user places a check mark in box 38, system 10 will detect its presence.

Claim 13:

Cooper teaches the method of claim 1 and further comprises:

wherein identifying at least one action set forth in the image comprises identifying a location of a mark in an action indication area on the image.

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefine services, such as storing, copying,

printing, publishing, deleting, add comments or rating.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said identifying at least one action set forth in the image comprises identifying a location of a mark in an action indication area on the image as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input /output device - See Grasso at the Abstract and at Para 9.

Claim 14:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein the at least one documents comprises a collection of documents.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 as illustrated in Fig. 4 above.)

Claim 15:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein the at least one document is part of a stored collection, and further wherein the collection overview comprises a collection coversheet.

(See Column 8 Lines 60-67 → Klotz discloses this limitation in that the document processing system 10 scans document surrogate 62 and parses the machine readable code resident on the surrogate. A flag indicates that the sheet is a document surrogate to be processed accordingly, and then remotely distributed as the hardcopy version of associated object 64 via facsimile transmission or any other means of distribution, as depicted as output terminal 18.)

Claim 16:

Klotz and Grasso teach the method of claim 15 and further comprise:

wherein the collection overview comprises a plurality of thumbnail depictions of documents.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 (i.e. thumbnail) as illustrated in Fig. 4.)

Claim 17:

Klotz and Grasso teach the method of claim 15 and further comprise:

wherein the collection coversheet comprises a machine-readable collection identifier specifying a storage location for the collection, the method further comprising, prior to performing at least one action, retrieving the at least one document from the storage location.

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 (i.e. thumbnail) as illustrated in Fig. 4. Further Klotz at the Abstract discloses the reference code encodes an indicator to the storage location of the associated objects.)

Claim 18:

Klotz and Grasso teach the method of claim 1 and further comprise:

wherein the collection overview comprises a list of documents.

(See Klotz at Column 4, Lines 1-5, teaching this limitation in that a catalog listing of multiple documents stored in the document processing system.)

Claim 19:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein the collection overview comprises a plurality of
thumbnail depictions of documents.**

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 (i.e. thumbnail) as illustrated in Fig. 4. Further Klotz at the Abstract discloses the reference code encodes an indicator to the storage location of the associated objects.)

Claim 20:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein the collection overview comprises a plurality of icons
representing documents.**

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 (i.e. icons) as illustrated in Fig. 4. Further Klotz at the Abstract discloses the reference code encodes an indicator to the storage location of the associated objects.)

Claim 21:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein the at least one action specifies a grouping action,
and wherein the at least one document comprises two or more
documents, and wherein performing the at least one action
comprises grouping the two or more documents.**

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as storing, copying, printing, publishing, and deleting, add comments or rating.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said at least one action specifies a grouping action, and wherein the at least one document comprises two or more documents, and wherein performing the at least one action comprises grouping the two or more documents as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input/output device

- See Grasso at the Abstract and at Para 9.

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Claim 22:

Klotz and Grasso teach the method of claim 20 and further comprise:

**wherein grouping the two or more documents comprises
forming a sub-collection comprising the two or more documents.**

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the sub-document as reduced images item 86 as illustrated in Fig. 4.)

Claim 23:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein the at least one action comprises transmitting the at
least one document to a destination, the method further comprising
determining a destination.**

(See at Column 2, Lines 55-65, Lines → Klotz discloses this limitation in that the document surrogates can then be scanned and transmitted to the document processing system via a remote facsimile transmission or other transmission means.)

Claim 24:

Klotz and Grasso teach the method of claim 23 and further comprise:

**wherein determining a destination comprises receiving user
input specifying a destination.**

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(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses might be supplied by some user interface.)

Claim 25:

Klotz and Grasso teach the method of claim 23 and further comprise:

**wherein determining a destination comprises reading an
indicator of a destination from the image.**

(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses might be supplied by some user interface, such as a panel on the front of system item 10.)

Claim 26:

Klotz and Grasso teach the method of claim 23 and further comprise:

wherein determining a destination,

(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses might be supplied by some user interface, such as a panel on the front of system item 10.)

In addition Klotz does not expressly teach, but Grasso teaches:

**wherein determining a destination comprises reading an
indicator of a destination from an action indication area in the image.**

(See the Abstract and Para 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefine services, such as storing, copying,

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printing, publishing, deleting, add comments or rating.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said determining a destination comprises reading an indicator of a destination from an action indication area in the image as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input /output device - See Grasso at the Abstract and at Para 9.

Claim 27:

Klotz and Grasso teach the method of claim 23 and further comprise:

wherein determining a destination comprises determining at least one selected from the group consisting of an e-mail address; a fax number; a uniform resource locator; a telephone number; and a mailing address;

(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses (i.e. e-mail address; a fax number; a uniform resource locator; a telephone number; and a mailing address) might be supplied by some user interface, such as a panel on the front of system item 10.)

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Claim 28:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein receiving the image of a document index comprises
receiving an e-mail message containing the image of the document
index;**

(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses (i.e. e-mail address; a fax number; a uniform resource locator; a telephone number; and a mailing address) might be supplied by some user interface, such as a panel on the front of system item 10. Further Klotz discloses the document processing system wherein an associated one of said one or more document processing functions is a distribution by electronic mail at Column 18, Line 19 and art Column 5, Lines 25-30.)

Claim 29:

Klotz and Grasso teach the method of claim 1 and further comprise:

**wherein receiving the image of a document index comprises
receiving a fax message containing the image of the document
index.**

(See at Column 8, Line 65 → Klotz discloses this limitation in that the distribution addresses (i.e. e-mail address; a fax number; a uniform resource locator; a telephone number; and a mailing address) might be supplied by some user interface, such as a panel on the front of system item 10. Further Klotz discloses at Column 13, Lines 35-50, the document processing system wherein an

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associated one of said one or more document processing functions is a fax primitives that includes fax page.)

Claim 30:

Klotz and Grasso teach the method of claim 1 and further comprise:

determining the at least one action by performing optical character recognition on an action indication area.

(See the Abstract and Para 11 and 19→ Grasso discloses this limitation in that the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as faxed or scanned or copied.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said determining the at least one action by performing optical character recognition on an action indication area as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input/output device - See Grasso at the Abstract and at Para 9.

Claim 31:

Klotz and Grasso teach the method of claim 8 and further comprise:

**wherein the machine readable identifier comprises an
identifier specifying a storage location,**

(See Figures 4 items 32, 84, 86 and at Column 13, Lines 50→ Column 14, Line 45 → Klotz discloses this limitation in that item 32 is a barcode represented documents items 84, included documents check boxes (i.e. marked) item 82 and the document reduced images item 86 (i.e. icons) as illustrated in Fig. 4. Further Klotz at the Abstract discloses the reference code encodes an indicator to the storage location of the associated objects.)

In addition Klotz does not expressly teach, but Grasso teaches:

**and the method further comprising, prior to performing the at
least one action, retrieving the at least one document from the
storage location.**

(See the Abstract and Para 11 and 19→ Grasso discloses this limitation in that creating and using forms. These forms are summaries (hereinafter "document surrogates") of associated objects, such as original documents, processes, or their copies, stored in a document processing system, wherein the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as faxed or scanned or copied.)

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Klotz's teaching to include a means of said performing the at least one action, retrieving the at least one document from the storage location as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input /output device - See Grasso at the Abstract and at Para 9.

Claim 32:

Klotz and Grasso teach the method of claim 8 and further comprise:

prior to performing the at least one action, retrieving the at least one document from a storage device,

(See the Abstract and Para 11 and 19→ Grasso discloses this limitation in that creating and using forms. These forms are summaries (hereinafter "document surrogates") of associated objects, such as original documents, processes, or their copies, stored in a document processing system, wherein the cover sheet becomes an input, output and surrogate document, in that the coversheet included check boxes for selecting predefined services, such as faxed or scanned or copied.)

Accordingly, it would have been obvious to a person of ordinary skill in the

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art at the time the invention was made to have modified Klotz's teaching to include a means of said performing the at least one action, retrieving the at least one document from the storage location as taught by Grasso. One of the ordinary skills in the art would have been motivated to modify this combination, because they are from the same field of endeavor of document management, and provides a predictable result of said to generate the coversheet use of the printer output cover sheet as a leisure-related, customized cover sheet which is used as a Paper UI input /output device - See Grasso at the Abstract and at Para 9.

Claims 35-38 respectively:

The rejection of claims 2, 3, 6, and 7 respectively, fully incorporated, and are rejected along the same rationale.

Claims 39:

The rejection of claim 10 fully incorporated, and is rejected along the same rationale.

Claims 40-44 (respectively):

The rejection of claims 11-15 respectively, fully incorporated, and are rejected along the same rationale.

Claims 45-50 (respectively):

The rejection of claims 15-20 respectively, fully incorporated, and

are rejected along the same rationale.

Claims 51-60 (respectively):

The rejection of claims 23-32 respectively, fully incorporated and are rejected along the same rationale

Claims 62-63, 64, and 66-67 (respectively):

The rejection of claims 6, 7, 11, 14, and 3 respectively, fully incorporated, and are rejected along the same rationale.

Claims 68-71:

The rejection of claims 15, 15, 16, and 17 respectively, fully incorporated, and are rejected along the same rationale.

Claim 72:

The rejection of claim 5, fully incorporated, and is rejected along the same rationale.

Claims 73-77:

The rejection of claims 18, 16, 23, and 28 respectively, fully incorporated, and are rejected along the same rationale.

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should

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not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Argument

The Remarks filed on 2/27/2008 has been fully considered but are moot but in view of the new ground(s) of rejection. See the above Office Action for details.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Mon through Fri 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571)272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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/Quoc A. Tran/
Patent Examiner
Art Unit 2176
04/22/2008

/Rachna S Desai/
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